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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/603,356	06/25/2003	Thomas Daly		2566
7590	06/26/2006			
Clifford Kraft 320 Robin Hill Dr. Naperville, IL 60540			EXAMINER METZMAIER, DANIEL S	
			ART UNIT	PAPER NUMBER

1712

DATE MAILED: 06/26/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/603,356

Applicant(s)

DALY, THOMAS

Examiner

Daniel S. Metzmaier

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 Feb & 17 April 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 46-52, 54-59 and 62-67 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 46-52, 54-59 and 62-67 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____.

DETAILED ACTION

Claims 46-52, 54-59, and 62-67 are pending.

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submissions filed on February 15, 2006 and April 17, 2006 has been entered.

Claim Objections

2. Claims 58-59 and 62-67 are objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. Claim 58 limits said ester defined in 57 "is an alkyl or allyl ester". This is outside the scope of 57, which sets forth "one of R or R' contains a non-saturated fatty tail".

This rejection is alternative to the rejection under 35 USC 112, second paragraph that follows.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

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4. Claims 46-52, 54-59, and 62-67 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Claims 51-56 and 62-67 are considered to contain new matter. Applicants have not set forth the basis for said newly claimed subject matter.

In claim 46, it is unclear where applicants provide basis for the terms "non-saturated fatty tail".

The original claims set forth "a surfactant" comprising the bromo-nitro molecule of the original independent claims. The specification only mentions the corrosion (page 2, lines 8-11) regarding an increase in corrosion due to a drop in pH resulting from bacterial degradation. The specification only mentions fatty acids regarding the formation of the bromo-nitro esters. The specification is silent regarding a metal working fluid further containing each of an oil, water or a base *per se*. It is further noted the metal working fluid base provided in example 1 is acid catalyzed with sulfuric acid and would be expected to be at least slightly acidic without some form of neutralization.

The claims include as R and R', which can be the same or different, an "allyl" group with 12 to 22 carbon atoms. An allyl group has the accepted definition as $\text{CH}_2=\text{CH}-\text{CH}_2-$. Applicants do not disclose an allyl group in their original disclosure. Said claimed group is new matter. It is noted that while the fatty tail is defined as an

oleate in some of the dependent claims, the claims require R and/or R' to be oleate, allowing for R or R' to be allyl.

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 46-47, 57-59 and 62-67 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The transitional language, "consisting of essentially" is indefinite regarding applicant's intended scope of the claims. Transitional language that has been litigated and has an accepted meaning in patent law is "consisting essentially of". Furthermore and since "containing" has the same meaning as "comprising", it is suggested applicant employ "an ester having a bromo-nitro moiety" in claim 57.

Regarding claims 46-47, compare lines 2 and 3 of claim 46, which employs the language, "consisting essentially of" and "comprising, respectively.

It is further noted that claims 62-67 employ the transitional language, "containing", which is interpreted to be synonymous with "comprising". Claim 57 employs the transitional language, "consisting essentially of". It is unclear what is intended as the scope of said claims.

The scope of claims 58-59 and 62-67 are indefinite since "allyl" is defined as "CH₂=CH-CH₂-". While said group is a non-saturated group, it would not be considered fatty and would not include an oleic tail.

Claim Rejections - 35 USC § 102

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

8. Claim 48 is rejected under 35 U.S.C. 102(b) as being anticipated by Shintoo Fine KK, JP 2000053502 A, as evidenced by Derwent Abstract AN 2000-353243 and JPO machine translation. Shinto Fine KK (see Derwent Abstract) discloses industrial microbiocide and microbiostatic having use in industrial aqueous systems, wherein R1 and R2 are defined as alkyl groups of 1-12 carbons or allyl groups. Shintoo Fine KK (paragraph [0001], Field of the Invention) discloses the industrial microbiocide and microbiostatic agents for use in industrial water systems including metalworking fluid. Said disclosure anticipates the claimed compositions.

Claim Rejections - 35 USC § 103

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claim 48 is rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over ICI Ind. Limited (hereafter ICI), GB 2 007 215 A. ICI (abstract; page 1, lines 10 et seq; page 2, lines 33-37) discloses biocidal compounds having use in industrial fluids including metal-working fluids. ICI

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(page 2, lines 10 et seq; and page 1, lines 59 et seq) discloses Y as a direct bond and R to include substituted, unsubstituted, branched, or straight chain alkyl groups or an optionally substituted alkenyl group. ICI (page 1, lines 59 et seq) list specific acids. Claim 48 reads on the disclosure of ICI alkenyl groups as R.

To the extent ICI differs from the claims in the sufficient specificity of the at least one non-saturated fatty tail claimed, ICI broadly suggest R groups as alkenyl groups and the hydrocarbon groups otherwise are defined as having 1 to 18 carbon atoms. It would have been obvious to one of ordinary skilled in the art at the time of applicants' invention to employ an alkenyl group for R having a chain length within the disclosed hydrocarbon range otherwise disclosed in the ICI reference and reading on the claimed non-saturated fatty tail.

11. Claims 46-47, 49-52, 54-59, and 62-67 are rejected under 35 U.S.C. 103(a) as being unpatentable over ICI Ind. Limited (hereafter ICI), GB 2 007 215 A. ICI (abstract; page 1, lines 10 et seq; page 2, lines 33-37) discloses biocidal compounds having use in industrial fluids including metal-working fluids. ICI (page 2, lines 10 et seq; and page 1, lines 59 et seq) discloses Y as a direct bond and R to include substituted, unsubstituted, branched, or straight chain alkyl groups or an optionally substituted alkenyl group. ICI (page 1, lines 59 et seq) list specific acids. Claim 48 reads on the disclosure of ICI alkenyl groups as R.

ICI differs from the claims in the sufficient specificity of the at least one non-saturated fatty tail claimed or the use of oleic acid as R.

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ICI (page 1, lines 10 et seq, and line 59 et seq) broadly discloses ester compounds as alkenyl groups and the hydrocarbon groups otherwise are defined as having 1 to 18 carbon atoms. While ICI does not specifically mention the use of oleic acid as a ester forming fatty acid, it would have been obvious to one of ordinary skilled in the art at the time of applicants' invention to employ oleic acid as an alkenyl group for R having a chain length within the disclosed 1-18 carbon number range otherwise disclosed in the ICI reference as a biocidal compound broadly taught and suggested in the ICI reference for the advantage of increasing the hydrophobicity of the compounds.

Double Patenting

12. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

13. Claims 46-50 and 57-59 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-3 of copending

Application No. 11/209,377. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims differ only in the preamble and the composition is otherwise indistinct based on the structures defined.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Response to Arguments

14. Applicant's arguments filed February 15, 2006 have been fully considered but they are not persuasive.

15. Applicant (page 8) asserts that it is well known that metal working fluids containing the now claimed components, therefore applicant asserts the claims are proper. This has not been deemed persuasive since it is unclear what concepts and/or scope was contemplated.

While applicant sets forth in the background of the invention that "most" MWFs are alkaline, said description cannot form the basis for now claiming a base in said MWF.

Applicant asserts the example discloses the addition of the claimed agent to a "standard MWF base", these would contain oil and surfactant and many times contain corrosion inhibitors, and it would be expected to contain excess oleic acid used in forming the agent. This has not been deemed persuasive since the MWF base is undefined.

To the extent applicant is asserting that these components are inherent, said inherent components should be commensurate in scope with those components that

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have been shown to be inherent. Applicant has presented no evidence to establish facts supporting any assertions of inherent components, i.e., collaborated notebooks showing the Standard MWF base. Any evidence should be in oath or declaration form.

Applicant cannot now insert a meaning that they deem to be known in the art or expected by those working in the art that were not clearly set forth and contemplated in the specification as originally filed. Said claimed insertions are deemed new matter.

16. Applicant (pages 11 and 12) asserts neither the Shintoo Fine KK reference fails to disclose or suggest the claimed oleate agents to prevent biodegradation in metal working fluids. This has not been deemed persuasive for the following claim 48, which is not limited to oleates.


Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Daniel S. Metzmaier whose telephone number is (571) 272-1089. The examiner can normally be reached on 9:00 AM to 5:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Randy P. Gulakowski can be reached on (571) 272-1302. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.


Daniel S. Metzmaier
Primary Examiner
Art Unit 1712

DSM